

Appeal No. 2004-1825

App. No. 09 402 563

Paper dated August 22, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

VAN ROMUNDE ET AL

SERIAL NO. 09 402 563

FILED: OCTOBER 5 1999

FOR: SYSTEM AND METHOD FOR
STEERING INTERRELATED ACTIONS

Commissioner for Patents
Alexandria, VA 22313

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Art Unit: 2163

Examiner: ROBINSON BOYCE

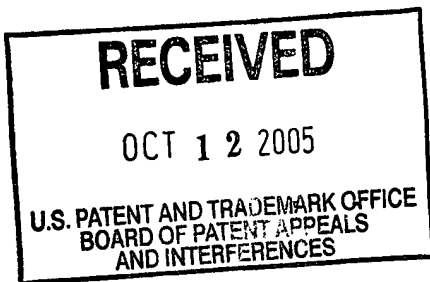
Docket No: KOB 10

SUBMISSION OF REQUEST FOR REHEARING

Sir:

Applicants enclose a Request for Rehearing under 37 CFR 41.50(b)(2) on the new ground of rejection in the Board decision mailed April 22, 2005. Pursuant to the recommendation in MPEP §1214.01(II), a Request for Rehearing under 37 CFR 41.52(a)(1) of the affirmance of the Examiner's rejections in the same Board decision is also enclosed as a separate paper..

The period for filing these Requests was extended to August 22, 2005 in response to a Petition for Extension of Time which was granted by the Board on June 21, 2005.



Respectfully submitted,

VAN ROMUNDE ET AL

BY

Maria Parrish Tungol
Registration No. 31,720
Telephone: (571) 275-1111

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By

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Appeal No. 2004-1825
Appl. No. 09 402 563
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

AN ROMUNDE ET AL

SERIAL NO. 09 402 563

Art Unit: 3623

FILED: OCTOBER 5 1999

Examiner:

ROBINSON-BOYCE

FOR: SYSTEM AND METHOD FOR
STEERING INTERRELATED
ACTIONS

Docket No: KOB 10

Commissioner for Patents
Alexandria, VA 22313

REQUEST FOR REHEARING UNDER 37 CFR 41.50(b)(2)

Sir:

This is Request for Rehearing of the new ground of rejection of claim 11 made by the Board pursuant to 37 CFR 41.50(b) in the Decision mailed April 22, 2005.

To facilitate consideration by the Board, a Request for Rehearing under 37 CFR 41.52(a)(1) of the affirmance of the Examiner's Final rejection of claims 1-3, 5-10, 12-14, 16, and 17 in above Board Decision is being submitted in a separate paper concurrently with this Request (MPEP §1214.01 (II)).

STATUS OF CLAIMS

The Examiner's Final rejection of claim 11 under 35 U.S.C. §102 was reversed by the Board. The Board entered a new ground of rejection of claim 11 pursuant to the provisions of 37 CFR 41.50(b).

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By



Appeal No. 2004-1825
Appl. No. **09 402 563**
Paper dated August 22, 2005

STATUS OF CLAIMS

The following claim 11 stands newly rejected under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention:

Claim 11. Method according to claim 1, wherein the steering software is an application embodiment of commercial LOTUS NOTES and/or LOTUS DOMINO NOTES software.

The Board has taken the position that, since the claim does not specify the versions or dates of the Lotus Notes and Lotus Domino Notes, “the scope of the claim is unclear”.

ARGUMENT

The test for definiteness under 35 U.S.C. 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

Lotus Notes has been a well known software product of Lotus Development Corporation since 1989. Appellants submit that, over the past 16 years, Lotus Notes and Lotus Domino are well known programs in the computer industry with a large established user base in business all over the world. Appellants submit that the programs are so well documented that one skilled in the art, after reviewing the specification, would readily determine the scope of claim 11 without recitation of the particular version. Furthermore, recitation of the date is not necessary since the filing date of the priority application would indicate the time frame of the Lotus Notes program used in the present invention to one skilled in the art.

Correlation of certain feature of Appellants’ method with the capabilities of Lotus Notes/Lotus Notes Domino is shown on page 8-9 of Appellants’ specification. Appellants submit that, given the filing dates of the application, the description of the elements and features of the claimed method and results thereof and correlation with Lotus Notes in Appellants’ specification, one skilled in the art would readily determine the scope of claim 11.

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Appellants submit that their position is supported by the fact that claim 11 was reviewed by the Examiner, a Supervisory Patent Examiner in Technology Center 3630, and an Appeal Conference Specialist, all of whom are presumed to have ordinary skill in the art of the present application. They were able to determine the scope of the claim and did not find claim 11 indefinite for not reciting "the version or dates" of Lotus Notes or Lotus Domino. Since 1998, the USPTO has issued at least 13 patents containing dependent claims which recite Lotus Notes without a version or date. The specifications of the patents do not disclose any version number for Lotus Notes. Like these examiners, one skilled in the art would readily determine the scope of claim 11.

In view of the above and, if the Board maintains the new ground of rejection, Appellants respectfully request that the Board state the specific technical reason(s) for their position that one skilled in computer science/programming would not be able to determine the scope of claim 11 in light of Appellants' specification without recitation of the version of programs as well known and widely used as Lotus Notes and Lotus Domino.

Applicants submit that claim 11 is in conformity with 35 U.S.C. §112, second paragraph. Withdrawal of the Board's new ground of rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

Respectfully submitted,

VAN ROMUNDE ET AL

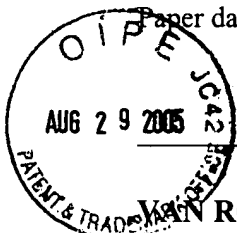
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Technology Center 2100

JOHN ROMUNDE ET AL

SERIAL NO. 09 402 563

Art Unit: 3623

FILED: OCTOBER 5 1999

Examiner:

ROBINSON-BOYCE

FOR: SYSTEM AND METHOD FOR
STEERING INTERRELATED
ACTIONS

Docket No: KOB 10

Commissioner for Patents
Alexandria, VA 22313

REQUEST FOR REHEARING UNDER 37 CFR 41.52(a)(1)

Sir:

This is Request for Rehearing of the affirmance of the Primary Examiner's Final rejection of claims 1-3, 5-10, 12-14, 16, and 17 in the Board Decision mailed April 22, 2005.

The rejection of claim 11 was reversed and the Board made a new ground of rejection of claim 11 under 37 CFR 41.50(b). To facilitate consideration by the Board, a Request for Rehearing under 37 CFR 41.50(b)(2) of the new ground of rejection is being submitted concurrently in a separate paper (MPEP §1214.01 (II)).

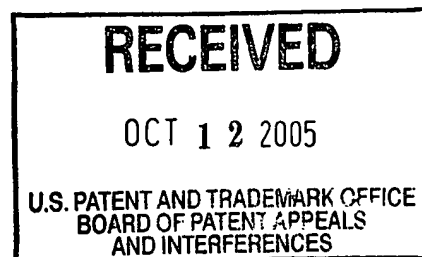
STATUS OF CLAIMS

The Examiner's Final rejection of claims 1-3, 5-10, 12-14, 16, and 17 under 35 U.S.C. §102(b) as anticipated by McIlroy et al. stands affirmed by the Board.

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Paper dated August 22, 2005

RELIEF REQUESTED

For the reasons discussed hereafter, Appellants respectfully request that the Board reconsider its affirmance of the Examiner's Final rejections of the above claims and reverse the Examiner's Final rejections of claims 1-3, 5-10, 12-14, 16, and 17.

If the Board decides not to reverse the Examiner's rejections, Appellants respectfully request that the Board designate its affirmance as a new ground of rejection since 1) the Board cited a new reference, Webster's II New Riverside University Dictionary, to support different bases for anticipation of certain elements of Appellants' claims and 2) the evidence cited by the Board in McIlroy and the bases relied upon by the Board for its affirmance are so different from the evidence and bases employed by the Examiner as to amount to new grounds of rejection.

GROUPING OF CLAIMS UNDER CONSIDERATION HEREIN

Group 1: Claims 1, 5-10, 12, 16, and 17 which are the generic claims in the application.

Group 2: Claims 2-3 and 13-14 which are directed to preferred embodiments of the method and computer system of the generic claims.

ARGUMENT FOR REVERSAL OF EXAMINER'S REJECTIONS

In view of the number of elements of the claims at issue, Appellants attach Appendix 2 which is a table showing the element of the claim at issue, the Examiner's bases for the rejections under §102, and the Board's bases for affirming the Examiner's rejections. The table shows that for most of the claim elements at issue, the Board did not adopt the sections of the reference and the bases set forth in the Examiner's Answer. Instead, the Board affirmed the Examiner's rejections citing different sections of McIlroy, stating different bases for the rejection, and cited a new reference to support the Board's new bases, namely the Board's interpretation of the phrase "in function of" and the term "operation".

The standard for anticipation is one of strict identity. To anticipate a claim for a patent, a single prior source must contain *all* its essential elements. Federal Circuit court decisions repeatedly emphasize that anticipation (lack of novelty) is established only if (1) *all* the elements of

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an invention, as stated in a patent claim, (2) *are identically set forth*, (3) in a single prior art reference. Federal Circuit decisions reject any standard of “substantial identity” (emphasis added), *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Appellant submits that the Board’s failure to adopt all the sections of McIlroy and the bases set forth cited by the Examiner claims supports Appellants’ position that the Examiner’s Final rejections and Answer did *not* establish that McIlroy discloses *all* of the elements of Appellants’ claims.

For the reasons discussed hereafter, Appellants submit that the new bases set forth in the Board Decision do not establish that McIlroy discloses all of the elements of Appellants’ claims.

The Federal Circuit has held that “[T]he identical invention must be shown *in as complete detail as is contained in the . . . claim.*” (emphasis added) *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “. . . exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference”. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574, 224 USPQ 409, 411 (Fed. Cir. 1984).

Appellants submit that neither the Examiner nor the Board has established that McIlroy discloses all of the element of Appellants’ claimed invention in as complete detail as contained in the claim. As discussed hereafter, the Board overlooked admissions by the Examiner, certain disclosures in Appellants’ specification and certain arguments in the Brief. The Board also overlooked/misapprehended elements of the claims and disclosures in McIlroy.

GROUP 1

ELEMENT 1: “Method . . . involving at least one recorded catalogue of recommended actions . . . wherein said . . . recorded catalogue of recommended actions comprises hierarchised sequences of alternative actions”

The Board overlooked 1) that the “at least one recorded catalogue of recommended actions” is comprised of “hierarchised sequences of alternative actions”, 2) Appellants’ arguments regarding Figures 7, 15, and 16, and 3) the Examiner’s admissions.

On pages 5-9 of the Brief, Appellants argued that the sections of McIlroy cited by the Examiner did *not* disclose a recorded catalogue of recommended actions *comprised of hierarchised sequences of alternative actions*. The Board did not adopt the Examiner's position that Element 1 of the claim is disclosed in columns 5, 7, and 9 of McIlroy (page 5-6 of the Answer). Instead, the Board took a different position, citing different sections of McIlroy:

“We do not find in appellants' specification any limitation of the meaning of 'recorded catalogue'. Hence we interpret that term as including McIlroy's catalogues of recommended actions in figures 7 and 15 and 16 that are generated from the recorded catalogues of treatments in figures 8a and 8b (col. 7, lines 26-29).” (page 4 of the Decision)

On page 5, the Board stated its position that Figures 15 and 16 show a hierarchy of alternative treatments. It is noted that the Board does not contend that the list alternative treatments in Figures 15 and 16 are recorded.

Appellants submit that the Board overlooked the fact that the catalogue of element 1 is not just “a recorded catalogue” as stated in the Decision. The catalogue is a) recorded *and* 2) comprised of hierarchised sequences of alternative actions. The Board overlooked the fact that the Examiner did not dispute Appellants' arguments regarding Figures 7, 15, and 16 and thereby conceding and /or admitting that Element 1 is not anticipated by these disclosures.

The Examiner did not dispute Appellants' arguments that “the only recorded catalogue of recommended actions in the method of McIlroy et al. is the list of treatment options shown in Fig. 7 as a guideline database item” and “[T]he treatment options as shown in Fig. 7 are not listed as 'hierarchised sequences of alternative actions'. There is no indication of any hierarchy in the list of the alternative actions in Fig. 7.” (pages 8-9 of the Brief). Therefore, Appellants submit that the Examiner conceded and/or admitted that the list of actions in Figure 7 is not a recorded catalogue comprised of hierarchical sequences of alternative actions.

In affirming the Examiner by citing Figure 7, the Board is overlooked the lack of hierarchy in the list of Figure 7 as noted in Appellants' arguments. The Board's reference in the Decision to “hierarchy” is limited to Figures 15 and 16 which are not recorded.

It appears that, unlike the Examiner, the Board is citing the lists in Figures 8a and 8b as showing “recorded catalogues of treatments”. However, the Board apparently overlooked the fact that, like the list in Figure 7, the lists in Figures 8a and 8b are *not* “hierarchical sequences”.

Neither the Examiner nor the Board dispute Appellants’ arguments that

“[T]he list of treatment options in “a final recommendation phase, which present recommendations to the patient” (Figs. 15 and 16) is comprised of treatment options retrieved from the list in the guideline database. However, the list in Figs. 15 and 16 is only displayed. There is no evidence that this particular list is actually recorded. Therefore, “at least one recorded list of recommended actions” is not readable on the list of final recommended treatments of McIlroy et al. in Figs. 15 and 16 (page 8 of the Brief).

Appellants submit that, by not disputing the argument, the Examiner *admitted* that the list in Figures 15 and 16 are not recorded. In affirming the Examiner’s rejections, Appellants submit that the Board overlooked this admission by the Examiner. Appellants submit that the Board has apparently overlooked the fact that there is *no disclosure in McIlroy* that the list of treatments in Figures 15 and 16 are recorded. Therefore, Appellants submit that these lists are not *identical* to element 1 of Appellants’ claims.

In the Brief, Appellants argued that “[T]here is no support for the Examiner’s conclusion that “therefore the most valuable treatments will be presented first”. Appellants submit that the Board misapprehended the lists in Figures 15 and 16 as being “hierarchical”. Neither the Examiner nor the Board cited any disclosure in McIlroy that treatment options 2A) and 2B) in Figs. 15 and 16 are listed in hierarchical order, i.e., that 2A) is preferred over 2B). (“anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product”, *Ex parte Standish*, 10 USPQ2d 1454, 1457 (Bd. Pat. App. & Int’f 1989)). Appellants also submit that there is no evidence that the other treatments, 2C) and 2D), appear in any hierarchical order.

The burden is on the USPTO to establish anticipation of all elements of the claims. The Examiner’s rejections should be reversed since neither the Examiner nor the Board have established that McIlroy discloses a “[M]ethod . . . involving at least one recorded catalogue of recommended actions . . . wherein said . . . recorded catalogue of recommended actions comprises hierarchised

sequences of alternative actions”.

ELEMENT 2: “Method . . . wherein . . . the method generates electronic evaluation forms hierarchically organized as forms and subforms”

The Board overlooked 1) the illustration of a form containing subforms on page 10 of the Brief and 2) all but one of certain disclosures relating to subforms in Appellants specification, and 3) the Examiner’s admissions in the Answer; the Board misapprehended Appellants’ Figure 1 and the form in Figure 11 as being a “subform” of Figure 10.

As indicated in Appellants’ Brief and the specification, subforms are known in the art. Appellants’ specification contains more disclosure regarding subforms than the single sentence quoted by the Board. Page 6 discloses:

A main form can comprise one or more sub-forms. A subform comprises a portion of the form. A subform can be integrated in several forms. This feature of the known office management systems is mainly used in administrative applications for those parts of the forms which are the same, for instance for letterheads, addresses, personal data, etc. (lines 11-18)

On page 8, line 14-15, the specification discloses that the present invention uses the capability of Lotus Notes/Lotus Domino Notes of providing “multiple forms having identical sub-forms”. On page 12, third column, the specification discloses that “[S]ubform is then incorporated in evaluation subform”.

In the Answer, the Examiner admits that the screens in Figures 10-17 are separate and distinct screens when she argued that “ the user must make a selection on one screen *to go to the next screen*” (emphasis added) (page 7 of the Answer) and “must click on an element in one form *to get to the next form* (Fig. 10 to Fig. 11)” (page 8 of the Answer). Since the user must perform an action to get from the form of Figure 10 to that of Figure 11, there is no integration of the two forms. Neither the Examiner nor the Board have established that the form of Figure 10 comprises the form of Figure 11.

The following illustration of a main form, “Customers”, comprising two subforms, “Orders” and “Order Details”, included on page 10 of the Brief is consistent with Appellants’ disclosure and the known meaning of subform:

The screenshot shows a Microsoft Access form titled "Customers". It is divided into three main sections:

- Main form:** Contains fields for customer information: CustID (1), ContName (Adams), City (San Francisco), State (CA), Country (USA), Phone (415) 555-1212, and Fax (415) 555-1213.
- Subform:** Contains a table with columns: OrderID, CustomerID, EmployeeID, OrderDate, PurchaseOrder, and ShipDate. The table has three rows of data.
- Subform:** Contains a table with columns: OrderID, OrderDate, ProductID, Quantity, Order Details, Unit Price, and Discount. The table has three rows of data.

Navigation buttons are located at the bottom of the form, labeled "Main form's navigation buttons", "Subform's navigation buttons", and "Subform's navigation buttons".

The capability of having multiple forms with identical subforms described in the specification supports Appellants' statement in the Brief that "[W]hen a subform is changed, all of the forms containing that subform automatically reflect the changes. Appellants' disclosures that "[A] main form can comprise one or more sub-forms. A subform comprises a portion of the form. A subform can be integrated in several forms" supports Appellants' statement that "[T]he subform will behave and appear to the end user as if it were an integral part of the form".

The forms in Figures 11-16 of McIlroy are not subforms because they do not have the properties/capabilities described in the specification or the properties/capabilities known in the art for subforms. In the Answer, the Examiner does not point to any teachings of McIlroy other than the forms shown in the figures. The Examiner did not present any technical reasoning as to how the form in Figure 10 is comprised of the form of Figure 11, Figure 11 is comprised of Figure 12, etc. The Examiner does not make any attempt to explain how the form in Figure 10 can comprise one or more of the forms of Figures 11-16. The Examiner does not attempt to explain how the form of Figure 11 could be integrated in several forms. As noted previously, the Examiner's own arguments show that the form in Figure 11 does *not* behave and does *not* appear to the end user as if it were an integral part of the form of Figure 10.

In the Answer, the Examiner did not state any interpretation of the term “subform” that supports her contentions. The burden is *on the Examiner* to establish anticipation but she did not present any evidence or adequate logical reasoning to support her contention that “the form in Figure 11 is a sub-form of the form in Figure 10 since the form comes from the selection made through the form of Figure 10” or her contention that the forms are “embedded as well since a user must click on an element on one form to get to the next form (Fig. 10 to Fig. 11)”. It is noted that her use of the term “embedded” is not consistent with the ordinary reasonable meaning of the term. The button(s) clicked on to access the form of Figure 11 is “embedded” in Figure 10. The form of Figure 11 is *not* embedded in Figure 10.

As discussed in more detail in connection with Element 6, the Examiner’s contention relating to the alleged disclosure in McIlroy of transferring forms and subforms into one file is *not* supported by McIlroy in col. 18 or any other section of the reference.

Appellant submit that the Board misapprehended Appellants’ Figure 1 as showing that “appellants’ subforms appear to include screens that are generated from another screen”. As described in the specification, Figure 1 shows subforms being used as links between a process form and an evaluation form to generate an evaluation form comprised of several subforms incorporated in one evaluation form in the manner shown in the above illustration. The use of the subforms as links does not change their characteristics such as the characteristics set forth in the specification.

The forms shown in Figures 11-16 of McIlroy are not capable of being incorporated into another form. Neither the Examiner nor the Board has presented any evidence or technical reasoning that any of these forms could be incorporated into the previously generated form or any other form.

The Examiner’s rejections should be reversed since neither the Examiner nor the Board have established that McIlroy discloses a “[M]ethod . . . wherein . . . the method generates electronic evaluation forms hierarchically organized as forms and subforms”.

ELEMENT 3: “Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms”

The Board overlooked the claim’s recitation that “wherein for each of said steps . . .”, the procedural steps in the alternative actions of Figures 15 and 16 and Appellants’ arguments; the Board misapprehended the relationship of the forms Figures 15 and 16 with the preceding forms, and did not provide any reasoning for its conclusion.

The Board did not discuss and therefore did not adopt the Examiner’s position regarding Element 3. The Examiner only cited Figures 10-12 and did not cite Figures 13-16. The Board cited additional figures in McIlroy (Figures 13-16) and different bases for finding anticipation. The Board has taken the position that claim 1 “does not require that evaluation forms and subforms are generated *in* each step but, rather . . . *for* each step” (page 6 of Decision). The Board then concluded that: “McIlroy’s hierarchies of forms and subforms in figures 10-16 are generated for the sequential steps of the hierarchized alternative actions in figures 15 and 16”.

Appellants submit that the Board’s position is not supported by either McIlroy or technical reasoning. The forms in Figures 10-14 are generated *prior* to the generation of the list of alternative actions in the forms of Figures 15 and 16. How can Figures 10-14 be generated for each step in an action (e.g., 2B)) in a list when the list itself does not yet exist?

As argued in Appellants’ Brief, McIlroy does *not* generate any forms for each sequential steps of a treatment option. For example, in Figures 15 and 16, treatment 2B) includes two procedural steps. The method of McIlroy et al. does not generate any evaluation form for either step, let alone for *each* of the procedural step. McIlroy does *not* disclose generation of any form for the first step in 2B), the treatment with streptokinase or urokinase, nor any form to for the second step, treatment with heparin for 6 days after the initial 3 day treatment.

The Examiner’s rejections should be reversed since neither the Examiner nor the Board have established that McIlroy discloses a “Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms”.

ELEMENT 4: “Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . and *wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions . . .*”

The Board overlooked the meaning of “in function of” stated by the Examiner and supported by the specification as well as the definition used by the Board itself for Element 5 in favor of a dictionary definition which is not reasonable, divorced from any relevant context, and not supported by McIlroy or the specification; the Board also overlooked the law regarding interpretation of claim terms and Appellants’ relevant arguments in the Brief.

The Board did not discuss and therefore did not adopt the Examiner’s position regarding Element 4. The Examiner only cited Figure 12b and did not cite Figures 10-11 or 13-16. The Board cited additional figures in McIlroy (Figures 10-11 and 13-16) and different bases for finding anticipation. The Board cited a new reference, Webster’s Dictionary, to support the different bases set forth by the Board for its finding of anticipation.

Appellants submit that, for the reasons set forth in the Brief and this Request, McIlroy does not disclose either Element 1 or Element 2. Therefore, McIlroy does not disclose Element 4. Applicants further submit that the only sequences of alternative actions in McIlroy et al. are the treatment options retrieved by the system as shown in Figure 15/16. The Board cites Figures 15 and 16 as showing “the hierarchized sequences of alternative actions produced using the forms”. Appellants again note that neither the Examiner nor the Board dispute Appellants’ position that there is no evidence in McIlroy that the alternative treatment options of Figure 15 or 16 are recorded.

Nevertheless, the Board proceeds to find anticipation of Element 4 by selecting a dictionary definition of “function” that is not reasonable for the present circumstances, divorced from any relevant context, and not supported by or even accurate in the context of either McIlroy or the specification. Furthermore, the definition selected by the Board differs from the definition the Board itself used for “in function of” in Element 5. In that instance, the Board interpreted the phrase “in function of the past history of actions” as meaning “take into account past history” (page 8 of the Decision).

As discussed in more detail in the second section of this Request, Appellants submit that the citation of the new reference to support different bases for finding anticipation is tantamount to a new ground of rejection.

Appellants submit that the Board's selection of the "significance" aspect from the possible meanings of "function" is contrary to established patent law. During patent examination, the pending claims must be "given their broadest *reasonable* interpretation consistent with the specification." (emphasis added), *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that *those skilled in the art* would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

Appellants submit that the particular definition selected by the Board is neither relevant nor reasonable. One skilled in the art would not apply such meaning to either the method of McIlroy or Appellants' claims. As understood by the Examiner and by one skilled in the art from Appellants' specification, "in function of" is a translation version of the more common English language expression, "as a function of" (page 9, lines 12-13 of the Answer).

Appellants submit that the Board's contention that

"McIlroy's generation of the forms in figures 10-16 is closely related to the hierarchized sequences of alternative actions produced using the forms, as shown in figures 15 and 16, and the form generation is dependent for its significance upon the hierarchized of alternative actions that are generated"

is not supported by McIlroy or Appellants' specification and therefore does not support a finding of anticipation of Element 4.

Appellants submit that the forms of Figures 10-14 are not generated in function of the treatment options of Figures 15 and 16 because the list of treatment options therein does *not* exist until *after* information is inputted into forms such as those of Figures 10-14. Appellants again submit that no forms are generated as a function of *the treatment options* in Figures 15 and 16. The Specialist Review form in Figures 15 and 17 is generated as a function of the entry by the user of a treatment that "is not the same as the guideline option" (col. 13, lines 45-50).

The Examiner's rejections should be reversed since neither the Examiner nor the Board have established that McIlroy discloses a "Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . and *wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions . . .*"

ELEMENT 5: "Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . and wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, *and in function of the past history of actions. . .*"

The Board overlooked that Element 5 recites "in function of the past history of actions" and misapprehended the disclosure of McIlroy regarding the relationship between the forms of Figures 6 and Figures 15 and 16.

The Board did adopt the Examiner's position in the Answer wherein she cites Figure 12b. As discussed previously, the Board changes its interpretation of "in function of" from the "significance" definition to "take into account" (page 8 of the Decision). The Board took a different position from that of the Examiner and stated that, in McIlroy, "past history is taken into account", specifically referring to 53(05) 02D, "Severe dyspnea even after treatment with inhaled meds" in Figure 6. The Board contends that the forms in Figures 15 and 16 "are generated in function of the past history referred to in figure 6".

Appellants again submit that McIlroy does not disclose the other elements of the claims which are included in Element 5. With regard to the Board's contention that the forms in Figures 15 and 16 are generated "in function of" the past history of Figure 6, Appellants submits that the cited line in Figure 6 may relate to "past history", but McIlroy discloses and characterizes the information in Figure 6 as questions and answers. Appellants again submit that questions/answers are not alternative actions such as the alternative actions listed in Figures 15 and 16 of McIlroy.

The Examiner's rejections should be reversed since neither the Examiner nor the Board have established that McIlroy discloses "Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . and wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, *and in function of the past history of actions. . .*".

ELEMENT 6: "Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . so as to enable transfer of a group of *evaluation forms and subforms* in one operation into one file".

The Board misapprehended the disclosure of McIlroy relating to the transfer of information into one file as a teaching that McIlroy's method could enable transfer of a group of evaluation forms and subforms in one operation into one file.

For reasons discussed previously, Appellants submit that McIlroy does not disclose Elements 2 or 3 of Appellants' claims. Since McIlroy does not generate evaluation forms according to the present invention, the method of McIlroy does not enable transferring such forms into one file.

Element 6 relates to a capability of Appellants' claimed method which results from the hierachical order of the evaluation forms. As stated in the specification on page 6, lines 2-4, "[T]he hierarchy (of the forms) makes it possible to transfer a group of *forms*, such as the forms pertaining to one specific client, into one operation into one file" (emphasis added). Appellants again submit as they did in the Brief that the transfer of *information* relied upon by the Examiner is different from the transfer of the forms themselves so there is no anticipation. Her arguments show that she recognizes that information and the forms are distinct by referring to information as being "from the forms and subforms". Nevertheless, she asserts anticipation even as she argues that the aggregation of McIlroy is only "analogous" to transfer of information into one file. Federal Circuit decisions reject any standard of "substantial identity". "[A] claim is anticipated only if each and every element

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as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As admitted by the Examiner, the disclosure cited by the Examiner relating to the transfer of information is not identical to the transfer of the forms themselves.

The Board did not adopt the Examiner’s position and cited a different section of the new reference previously discussed and different sections of McIlroy to support its finding of anticipation. The Board has erroneously interpreted the term without any reference to either the specification or McIlroy as required by CAFC decisions. Appellants do not agree that the term “operation” is as limited as stated by the Board. Appellants submit that the term should be construed in conformity with the relevant case law. In any case, it is Appellants’ position that McIlroy’s lack of disclosure of any transfer or capability of transferring *forms* into one file is dispositive.

Appellants submit that the “disclosures” in McIlroy cited by the Board, namely, “that 1) the system is implemented on . . . personal computer using Microsoft C language, 2) all patient information is to be in a single file, and 3) information can be added to an existing file . . .” do not support the Board’s conclusion that these disclosures “indicates that the system enables transferring at least two *forms* into a single file using a single instruction” (emphasis added). Appellant submit that these disclosures do not disclose transfer of *forms* into one file in any way. Furthermore, the Board has not provided any technical reasoning to support its conclusion. The Board has not explained where McIlroy discloses that the implementation of a method on a personal computer using Microsoft C language would enable the system to transfer at least two *forms* into a single file. Appellants submit that the disclosure that all patient information is to be in a single file or added to an existing file does not provide any teaching about transferring the *forms* used to display that information into a single file or adding the forms to an existing file. Moreover, the Board has not provided any technical reasoning explaining how the cited disclosures support the Board’s conclusion.

As discussed in more detail in the second section of this Request, Appellants submit that the citation of the new reference to support different bases for finding anticipation is tantamount to a new ground of rejection.

The Examiner's rejections should be reversed since neither the Examiner nor the Board have established that McIlroy discloses a "Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . so as to enable transfer of a group of *evaluation forms and subforms* in one operation into one file"

GROUP 2

Element at issue: Method according to claim 1 wherein said . . . recorded catalogue of alternative actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions".

The Board overlooked the Examiner's admission that McIlroy does not disclose recorded algorithms and the requirement that a rejection based on inherency must be supported by technical reasoning or evidence.

Claim 2 relates to that aspect of the invention wherein the recorded catalogue of alternative actions include electronic selection algorithms. As noted in the Brief, the algorithm of McIlroy cited by the Examiner is *not* coded so the algorithm does not meet the limitation of being a recorded. The Board overlooked the Examiner's arguments on page 7 of the Answer in which she effectively admits that the algorithm is not recorded: "McIlroy clearly states that 'A guideline is . . . a definite step by step algorithm that *can be* coded', which *suggests* that coding the guideline of the present invention is an inventive *option*" (emphasis added).

Although the Examiner did not rely on the disclosure in Figures 8, 15, or 16, the Board cited these figures in asserting different basis, i.e., inherency, for finding anticipation:

McIlroy *necessarily must* have an algorithm for selecting the treatments in figures 15 and 16 from the menu in figure 8, and for specifying the recommended treatments and placing them at the beginning of the lists in figures 15 and 16 (emphasis added) (page 9 of the Decision)

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In reversing the rejection of claim 11 as anticipated under 35 U.S.C. §102 pages 9-10 of the Decision, the Board cited the relevant legal principles relating to anticipation by inherency:

When an examiner relies upon a theory of inherency, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990) . The examiner, however, has not provided that basis in fact and/or technical reasoning. . . .

The Board went on to note that “[T]he examiner has not explained how McIlroy discloses that limitation either expressly or under the principles of inherency” (page 10 of the Decision).

Appellants respectfully submit that the conclusory statement that “McIlroy necessarily must have an algorithm” is not sufficient to support a finding of anticipation. The Board’s decision does not provide any basis in fact or technical reasoning to support their position that the elements of claim 2 *necessarily* flow from the teachings of McIlroy especially in view of the Examiner’s admission that the algorithms are not recorded.

The Examiner’s rejections should be reversed since neither the Examiner nor the Board have established that McIlroy discloses a “Method according to claim 1 wherein said . . . recorded catalogue of alternative actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions”.

ARGUMENTS FOR DESIGNATION OF AFFIRMANCE AS NEW GROUNDS OF REJECTION PURSUANT TO 37 CFR 41.50(b).

If the Board decides not to reverse the Examiner’s rejections, Appellants respectfully request that the Board designate its affirmance as a new ground of rejection. As discussed previously, the Board cited a new reference to support very different bases for affirming the Examiner. Appellants submit that the citation of the new reference together with the substantive use of the reference to support different bases for the affirmance is tantamount to new grounds of rejection. “Ordinarily, citation by the board of a new reference, such as the dictionary in this case, and reliance thereon to support a rejection, will be considered as tantamount to the assertion of a new ground of rejection.”,

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In re William Boon, 169 U.S.P.Q. 231, 439 F.2d 724 (1971). “We here take judicial notice that it is not uncommon for the board itself to cite new references, in which case a new ground of rejection is always stated.”, *In re Wilhelm Ahlert and Ernst Kruger*, 165 U.S.P.Q. 418, 424 F.2d 1088 (1970).

The differences between the Examiner’s bases for the rejections and the Board’s bases for affirming the rejections were discussed in detail in the previous Argument section. The differences are also shown in the table of Appendix 2. Since the bases set forth by the Board for anticipation of most of the elements of claim 1 1) were wholly different from those of the Examiner, 2) changed the thrust of the rejections, and 3) necessitated different responses by Appellants, the Board’s affirmance amounted to new grounds of rejection. *In re Waymouth*, 486 F.2d 1058, 179 USPQ 627 (CCPA 1973), modified, 489 F.2d 1297, 180 USPQ 453 (CCPA 1974). See also *Ex parte Stern*, 13 USPQ2d 1379, 1383 (Bd. Pat. App. & Int’f 1989) (“the rationale underpinning our affirmance of the examiner’s rejection differed from the rationale employed by the examiner to such an extent that it amounted to a new ground of rejection”) and *Ex parte Bhide*, 42 USPQ2d 1441, 1448 (Bd. Pat. App. & Int’f 1996) (“our basis for concluding that the claims are unpatentable is based on a rationale and evidence which differs considerably from that of the examiner. Hence, we designate our decision affirming the examiner’s ‘decision,’ as being a new ground of rejection under 37 C.F.R. Section 1.196(b) . . . ” See also *In re Echerd*, 471 F.2d 632, 176 USPQ 321 (CCPA 1973) and *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971):

A finding such as was made here, however, supporting as it does an alternative ground for sustaining the examiner’s rejection, and apparently based on nothing more than a bare allegation of scientific fact, does everything but cry out for an opportunity to respond.

In *In re Eynde*, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973), the CCPA held that:

We do agree with appellants that where the board advances a position or rationale new to the proceedings, as it is empowered to do and quite capable of doing, the appellant must be afforded an opportunity to respond to that position or rationale by the submission of contradicting evidence.

Appellants submit that, because of the citation of a new reference and the extent of the changes in the bases for finding anticipation, the Board’s affirmance should be designated as new

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grounds of rejection under the provisions of 37 CFR 41.50(b) so that Appellant will be afforded a full opportunity to respond as provided by the rules.

Appellants respectfully request that the Board designate the affirmance of the Examiner's Final rejection as a new ground of rejection under 37 CFR 41.50 (b) so that Appellants may be afforded the procedural safeguards of the relevant rules, including but not limited to 37 CFR 41.52(a)(3).

CONCLUSION

For the reasons discussed herein, Appellants submit that the bases set forth in the Examiner's Answer and the Board Decision are not sufficient to establish that McIlroy discloses all of the elements of Appellants' claims in as complete detail as is contained in the claims. Therefore, anticipation under 35 U.S.C. §102 has not been established. Appellants respectfully request reconsideration of the Board's Decision and reversal of the Examiner's Final rejections under 35 U.S.C. §102.

The Board has cited a new reference and relied on different sections of the reference and different bases than those relied upon by the Examiner for its affirmance of the rejections. If the Board decides not to reverse the Examiner, Appellants respectfully request that the Board designate the affirmance of the Examiner's Final rejection as new grounds of rejection under 37 CFR 41.50 (b) so that Appellants may be afforded the procedural safeguards of that rule which include the option of submitting additional evidence and have the new rejection considered by the Examiner or having the new rejection considered by the Board on the existing record so that Appellants have permission to present new arguments pursuant to 37 CFR 41.52(a)(3).

Respectfully submitted,

VAN ROMUNDE ET AL

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APPENDIX 1

GROUP 1: Claims 1, 5-10, 12, 17, and 17 which are the generic claims in the application.

Claim 1. Method for electronically storing, retrieving and/or modifying records using a computer system comprising a display unit, an input unit, a memory unit and a processing unit, and involving at least one recorded catalogue of recommended actions, and for sequentially steering a process of interrelated actions from said at least one recorded catalogue of recommended actions, wherein said at least one recorded catalogue of recommended actions comprises hierarchised sequences of alternative actions, wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms, wherein said evaluation forms comprise a list of recommended actions, information-input requests and/or decision-requests, and wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, and in function of the past history of actions so as to enable transfer of a group of evaluation forms and subforms in one operation into one file.

Claim 5. Method according to claim 1, wherein said evaluation form comprises information from records relevant for a decision-request involved in said evaluation form.

Claim 6. Method according to claim 1, wherein a record of information entered and used is stored in said memory unit.

Claim 7. Method according to claim 1, wherein a record of the information and actions entered and used is stored in the memory unit for the purpose of measurement of the effectivity and/or efficiency of effects and/or results of the procedure.

Claim 8. Method according to claim 1, wherein the method involves a supervising organization for the purpose of quality control and quality improvement of the method.

Claim 9. Method according to claim 1, wherein the method allows for updating of the recorded catalogue(s) of recommended actions.

Claim 10. Method according to claim 7, wherein said supervising organisation evaluates the effectivity and/or efficiency of effects and/or results based on said records of information and actions used/entered, stored during use of the method, and up-dates the recorded catalogue(s) of recommended actions in function of said evaluation.

Claim 12. Computer system for electronically storing, retrieving and/or modifying records and for sequentially steering interrelated actions in respect of said records, comprising a display unit, an input unit, a memory unit and a processing unit, wherein said memory unit of the computer system comprises at least one recorded catalogue of recommended actions involving hierarchised sequences of alternative actions, and wherein said processing unit of the computer system is programmed to generate electronic evaluation forms, hierarchically organized as forms and subforms, comprising a list of recommended actions, information-input requests and/or decision-requests, in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, and in function of the past history of actions, so as to enable transfer of a group of evaluation forms and subforms in one operation into one file.

Claim 16. Computer system according to claim 12, wherein the processing unit of the computer system is programmed to integrate into the evaluation form information from the records which is relevant for a decision-request involved in said evaluation form.

Claim 17. Computer system according to claim 12, wherein the processing unit of the computer system is programmed to store a record of the information entered and actions used into the memory unit of the computer system.

GROUP 2: Claims 2-3 and 13-14 which are directed to preferred embodiments of the method and computer system of the generic claims wherein said at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions and wherein the selection algorithms are integrated in the generated electronic forms.

Claim 2. Method according to claim 1, wherein said at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions.

Claim 3. Method according to claim 2, wherein said selection algorithms are integrated in said generated electronic forms.

Claim 13. Computer system according to claim 12, wherein said at least one recorded catalogue of recommended actions in the memory unit of the computer system comprises associated

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electronic selection algorithms in respect of the hierarchised sequences of alternative actions.

Claim 14. Computer system according to claim 13, wherein the processing unit of the computer system is programmed to integrate said selection algorithms into said generated electronic forms.

APPENDIX 2

GROUP 1

Element of Claim 1 at Issue	Examiner's Bases in McIlroy for §102 Rejection in the Examiner's Answer	Board's Bases in McIlroy for Affirming Examiner's §102 Rejection
<p>Element 1 (pages 5-9 of the Brief):</p> <p>"Method . . . involving at least one recorded catalogue of recommended actions . . . wherein said . . . recorded catalogue of recommended actions comprises hierarchised sequences of alternative actions"</p>	<p>Pages 5-6 of Answer:</p> <p>disclosures in columns 5, 7, and 9 of the reference as "suggesting" this element of the claim; disclosure at col. 7, lines 26-29 of McIlroy is not cited by the Examiner;</p> <p>The Examiner did not cite Figure 7, Figure 15 or Figure 16 for this element of the claim.</p>	<p>Pages 4-5 of the Decision:</p> <p>"We do not find in appellants' specification any limitation of the meaning of 'recorded catalogue. Hence we interpret that term as including McIlroy's catalogues of recommended actions in figures 7 and 15 and 16 that are generated from the recorded catalogues of treatments in figures 8a and 8b (col. 7, lines 26-29)."</p> <p>and</p> <p>Figure 15 and 16 are cited as showing hierarchy of alternative treatments.</p>
<p>Element 2 (pages 10-11 of the Brief):</p> <p>" . . . wherein . . . the method generates electronic evaluation forms hierarchically organized as forms and subforms"</p>	<p>Pages 7-8 of Answer:</p> <p>Figures 10-17 are hierarchically organized as forms and subforms "since the user must make a selection on one screen to go to the next screen" . . . [T]he subforms come underneath the form in Fig. 10 . . . [T]hese forms are not only linked, but are embedded . . . since the user must click on an element in one form to get to the next form (Fig. 10 to Fig. 11)".</p>	<p>Pages 5-6 of the Decision:</p> <p>"specification does not indicate that 'subform' . . . is to be given the narrow interpretation argued by the appellants . . . the appellants' subforms (in Fig. 1) appear to include screens that are generated from another screen . . . we are not convinced that the . . . term 'subform' excludes . . . the screens in figures 11-16 (of McIlroy)".</p>
<p>Element 3 (page 11 of the Brief):</p> <p>"Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms"</p>	<p>Pages 8-9 of the Answer:</p> <p>"Figures 10-12b show forms that are sequentially generated."</p> <p>The Examiner did not cite figures 13-16 in the rejection.</p>	<p>Page 6 of the Decision:</p> <p>"McIlroy's hierarchies of forms and subforms in figures 10-16 are generated for the sequential steps of the hierarchized alternative actions in figures 15 and 16".</p>

Element of Claim 1 at Issue	Examiner's Bases in McIlroy for §102 Rejection in the Examiner's Answer	Board's Bases in McIlroy for Affirming Examiner's §102 Rejection
<p>Element 4 (pages 11-12 of the Brief):</p> <p>"Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . and wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions . . ."</p>	<p>Pages 4 and 9 of the Answer</p> <p>col. 3, lines 2-4 and col. 5, lines 21-45</p> <p>Examiner cites the question in Fig. 5, step 01D as an "action".</p> <p>"McIlroy et al. describes actions in Figure 12b where Embolectomy or thrombectomy, . . . are recommended actions for the related diagnosis.</p> <p>"In addition, McIlroy et al. disclose the hierarchised sequences of alternative actions of the recorded catalogue actions as described above in the preceding paragraphs".</p> <p>The Examiner did not cite any of Figures 10-11 and 15-16.</p>	<p>page 7 of the Decision</p> <p>Board uses definition of "function" as "[s]omething closely related to another thing and dependent on it for its existence, value, or significance".</p> <p>"McIlroy's generation of the forms in figures 10-16 is closely related to the hierarchized sequences of alternative actions produced using the forms, as shown in figures 15 and 16, and the form generation is dependent for its significance upon the hierarchized of alternative actions that are generated.</p> <p>Hence McIlroy's generation of forms is carried in function of the hierarchized sequences of alternative actions."</p>
<p>Element 5 (page 12 of the Brief):</p> <p>"Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . and wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, and in function of the past history of actions. . ."</p>	<p>Page 9-10</p> <p>col. 6, line 64-col 7, line 6</p> <p>"McIlroy describes actions in Figure 12b where Embolectomy or . . . femoropopliteal vein by leg incision are recommended actions for the related diagnosis. In addition, McIlroy disclose the hierarchised sequences of alternative actions of the recorded catalogue actions as described above in the preceding paragraphs".</p> <p>The Examiner did not cite Figure 6 of McIlroy.</p>	<p>Page 8 of the Decision</p> <p>"In that figure (Fig. 6), however, past history is taken into account ('severe dyspnea even after treatment with inhaled meds'). The forms in figures 15 and 16 showing recommended treatments are generated in function of the past history referred to in figure 6."</p>

Element of Claim 1 at Issue	Examiner's Bases in McIlroy for §102 Rejection in the Examiner's Answer	Board's Bases in McIlroy for Affirming Examiner's §102 Rejection
<p>Element 6 (page 13 of the Brief):</p> <p>"Method . . . wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms . . . so as to enable transfer of a group of <i>evaluation forms</i> and <i>subforms</i> in one operation into one file" (see page 5, line 34-page 6, line 8 of the specification).</p>	<p>page 10 of the Answer:</p> <p>"McIlroy et al. discloses . . . aggregation of proposed and final treatment combinations for each diagnosis. The aggregation of this information is <i>analogous</i> to <i>information</i> from the forms and subforms being transferred into one file . . . represented by the aggregation report".</p> <p>"Fig. 16 shows the transfer of the <i>information</i> from the forms and subforms into one file".</p>	<p>pages 8-9 of the Decision:</p> <p>"claim 1 does not require a step of transferring a group of evaluation forms and subforms into one operation into one file but, rather, merely requires that such transfer is enabled."</p> <p>"disclosure that 1) the system is implemented on . . . personal computer using Microsoft C language, 2) all patient information is to be in a single file, and 3) information can be added to an existing file . . . indicates that the system enables transferring at least two forms into a single file using a single instruction".</p>

GROUP 2

Element of Claim 2 at Issue	Examiner's Basis in McIlroy for §102 Rejection in the Examiner's Answer	Board's Basis in McIlroy for Affirming Examiner's §102 Rejection
<p>Element discussed on pages 14-15 of the Brief: Method according to claim 1 wherein said . . . recorded catalogue of alternative actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions”.</p>	<p>Page 7 and 11 of the Answer: Examiner cites disclosure of McIlroy at col. 3, lines 2-4 and stated: “it is disclosed that the guidelines used to drive the assessment and the final recommendation phase is a step-by-step algorithm in col. 7, lines 45-50 . . .</p> <p>“Appellant argues that the algorithm in McIlroy et al. is not disclosed as actually coded. . . . Col. 7 . . . of McIlroy clearly states that ‘A guideline is . . . a definite step by step algorithm that <i>can be coded</i>’, which <i>suggests</i> that coding the guideline of the present invention is an inventive <i>option</i>, thereby reinforcing the fact that this guideline is recordable” (page 7).</p> <p>“As explained previously, incorporating coded algorithm into the guideline of the present invention is an inventive <i>option</i> thereby reinforcing the fact that this guideline is recordable”.</p> <p>“McIlroy <i>suggest</i> that the assessment phase and final recommendation phase is viewed as a decision tree, which is a hierarchical representation”.</p> <p>The Examiner did not cite Figures 8, 15, or 16.</p>	<p>Page 9 of the Decision: “McIlroy necessarily must have an algorithm for selecting the treatments in figures 15 and 16 from the menu in figure 8, and for specifying the recommended treatments and placing them at the beginning of the lists in figures 15 and 16”.</p>

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operation • oppose

operation (ôp'ô-râ'shən) *n.* [ME *operacioun* < OFr. *operation* < Lat. *operatio* < *operari*, to work < *opus*, work.] 1. An act, process, or way of operating. 2. The condition of being operative or functioning <in full operation>. 3. A process or series of acts aimed at producing a desired result or effect <the operation of cleaning the house for the party>. 4. A method or process of productive activity. 5. Med. A procedure for remedying an ailment, injury, or dysfunction in a living body, esp. one performed with instruments. 6. Math. A procedure, as addition, subtraction, or differentiation, performed in a specified sequence and in accordance with specific rules. 7. Computer Sci. An action resulting from a single computer instruction. 8. a. A military or naval action or campaign. b. **operations**. The office at an airport or air base where pilots file flight plans and where flying from the field is controlled. c. **operations**. The office or agency, as of a corporation, that carries out overall planning and operating functions.

operational (ôp'ô-râ'shə-nəl) *adj.* 1. Of or relating to an operation or a series of operations. 2. Of, for, or engaged in military operations. 3. a. Serviced and declared ready for use <an operational aircraft>. b. Functioning properly. —**operationally** *adv.*

operations research *n.* Mathematical or scientific analysis of a governmental, military, or commercial operation in terms of its systematic performance and efficiency.

operative (ôp'ô-râ-tiv, ôp'rô-, -râ'tiv) *adj.* 1. Exerting influence or force. 2. Functioning effectively: EFFICIENT. 3. Being in effect or in operation <operative rules>. 4. Related to, concerned with, or engaged in mechanical or physical activity. 5. Of, relating to, or resulting from a surgical operation. —*n.* 1. A skilled worker, esp. in industry. 2. a. A secret or trusted agent. b. A private detective. —**operatively** *adv.*

operator (ôp'ô-râ-tôr) *n.* 1. One that operates a mechanical device <a crane operator>. 2. The owner or manager of a business. 3. A dealer in stocks or commodities. 4. A symbol, as a minus sign, that represents a mathematical operation. 5. Informal. A shrewd and occas. unscrupulous person who is adept at manipulating other persons or rules to his or her advantage. 6. A chromosomal sequence that is the region of an operon responsible for regulation of structural genes.

opercula (ôp'ô-kyô-lâ) *n.* var. pl. of **OPERCULUM**.

operculate (ôp'ô-kyô-lit) *also* **operculated** (-lâ'tid) *adj.* Having an operculum.

operculum (ôp'ô-kyô-ləm) *n.* pl. -la (-lâ) or -luma. [Lat., lid < *operire*, to cover.] 1. Biol. A flap or lid that covers or closes an aperture, as the gill cover in some fishes or the horny plate in certain mollusks that seals the shell opening. 2. Anat. A lid or flap, as the layer of tissue over an erupting tooth. —**opercular** *adj.* —**opercularity** *adv.*

opéretta (ôp'ô-rê-tâ) *n.* [Ital., dim. of *opera*, opera.] A theatrical production having many of the musical elements of opera but lighter in subject and style.

operon (ôp'ô-rôn) *n.* [< OPERATE.] A cluster of genes together with a distant gene that regulates the cluster's production of a set of different but functionally related enzymes.

opérose (ôp'ô-rôs) *adj.* [Lat. *operosus* < *opus*, work.] 1. Involving great labor: LABORIOUS. 2. Diligent: industrious. —**opérosely** *adv.* —**opéroseness** *n.*

ophidian (ôf'idē-ən) *n.* [< NLat. *Ophidia*, suborder name < Gk. *ophis*, snake.] A limbless reptile of the suborder Ophidia or Serpentes: SNAKE. —**ophidian** *adj.*

ophiology (ôf'idē-ô-jē, ôf'ē-) *n.* [Gk. *ophis*, snake + *-logy*.] The branch of herpetology concerned with snakes. —**ophiologist** *n.* —**ophiologic** (-ô-lôj'ô-lôg) *adj.* —**ophiologist** *n.*

ophiophagous (ôf'ē-ôf'ô-gəs) *adj.* [Gk. *ophis*, snake + *-phagous*.] Feeding on snakes.

ophite (ôf'it, ôf'it') *n.* [Lat. *ophites* < Gk. *ophites* (lithos), serpentlike (stone) < *ophis*, serpent.] 1. A mottled-green rock composed of diabase. 2. Any of various green rocks, as serpentine.

ophitic (ôf'it'ik, ôf'it') *adj.* 1. Of or relating to ophite. 2. Having a texture of plagioclase crystals in a matrix of pyroxene crystals.

ophiuchus (ôf'ē-yô'kəs, ôf'ē-) *n.* [Lat. < Gk. *ophiouchos* : *ophis*, serpent + *ekhein*, to hold.] A constellation in the equatorial region.

ophthalm- *pref.* var. of **OPHTHALMO-**

ophthalmia (ôf-thâl-mē-ô, ôp-) *also* **ophthalmitis** (ôf-thâl-mītis, -thâl-) *n.* [ME *obtalmia* < LLat. *ophthalmia* < Gk. < *ophthalmos*, eye.] Inflammation of the eye, esp. of the conjunctiva.

ophthalmic (ôf-thâl'mik, ôp-) *adj.* [Gk. *ophthalmikos* < *ophthalmos*, eye.] 1. Of or relating to the eye: OCULAR. 2. Having ophthalmia.

ophthalmitis (ôf-thâl-mītis, -thâl-) *n.* var. of **OPHTHALMIA**.

ophthalmo- or **ophthalm-** *pref.* [Gk. < *ophthalmos*, eye.] Eye: eyeball <ophthalmoscope>.

ophthalmologist (ôf-thâl-môl'ô-jist, ôf-thâl-, ôp-) *n.* A physician specializing in the treatment of diseases of the eye.

ophthalmology (ôf-thâl-môl'ô-jē, ôf-thâl-, ôp-) *n.* The medical specialty encompassing the anatomy, functions, pathology, and treatment of the eye. —**ophthalmologic** (-thâl-mô-lôj'ik), **ophthalmological** *adj.* —**ophthalmologically** *adv.*

ophthalmometer (ôf-thâl-môm'it-tôr, ôf-thâl-, ôp-) *n.* An optical instrument for measuring astigmatism. —**ophthalmometric** (ôf-thâl-môm'it'rik, ôp-) *adj.* —**ophthalmometrically** *adv.*

ophthalmoscope (ôf-thâl-mô-skôp, ôp-) *n.* An instrument consisting of a mirror with a central hole through which the eye is examined. —**ophthalmoscopic** (skôp'ik), **ophthalmoscopy** (ôf-thâl-mô-skôp'ô-pē, ôp-) *n.* —**ophthalmoscopy** *adj.*

opia *suff.* [NLat. < Gk. *-opia* < *ôpa*, eye.] A visual condition or defect of a specified kind <anisometropia>.

opiate (ôp'it, -ât) *n.* [Med. Lat. *opiatum* < *opiatu*, treated with opium < Lat. *opium*, opium.] 1. A sedative narcotic containing opium or an opium derivative. 2. Any sedative or narcotic drug.

opiate *adj.* 1. Something that numbs the senses or the mind. —*adv.* 1. Consisting of or containing opium. 2. Causing or producing sleep or sedation. 3. Dulling the senses or mental processes: DEADENING. —*vt.* (ôp'it-) *-ated, -ating, -ates*. 1. To subject to the action of an opiate. 2. To deaden or dull as if with a narcotic drug.

opine (ô-pin') *vt.* **opined, opining, opines**. [OFr. *opiner* < *opinari*, to suppose.] To hold or offer as an opinion: *He opined that...*

opinion (ô-pin'yən) *n.* [ME *opinioun* < Lat. *opinio* < *opinari*, to suppose.] 1. A belief or idea held with confidence but not substantiated by direct proof or knowledge. 2. An evaluation or conclusion based on special knowledge or expertise <a medical opinion>. 3. A judgment or estimation of the value or worth of a person or thing <had a high opinion of the new director>. 4. The common, usual, or prevailing view or sentiment <public opinion>. 5. Law. A formal statement by a judge or jury of the legal reasons and principles for the conclusions of the court.

opinionated (ô-pin'yô-nâ'tid) *adj.* Holding stubbornly and often unreasonably to one's personal opinions. —**opinionatedly** *adv.* —**opinionatedness** *n.*

opinionative (ô-pin'yô-nâ'tiv) *adj.* 1. Relating to, based on, or of the nature of an opinion <opinionative reasoning>. 2. Opinionated. —**opinionatively** *adv.*

opisthobranch (ô-pis'thô-brāŋk') *n.* pl. -branchia. [NLat. *Opisthobranchia*, order name: Gk. *opisthen*, behind + *Gk. brachion*, gill.] A marine gastropod of the order Opisthobranchia, marked by gills, a reduced or absent shell, and two pairs of tentacles.

opisthognathous (ôp'is-thôg'nâ-thəs) *adj.* [Gk. *opisthen*, behind + *-gnathous*.] Having receding jaws.

opium (ô-pē-əm) *n.* [ME < Lat. < Gk. *opion*, dim. of *opos*, juice.] 1. A bitter, yellowish-brown, highly addictive drug derived from the opium poppy, containing alkaloids, as morphine, codeine, narcotine, and papaverine, with strong anesthetic properties. 2. **OPAT**.

opium poppy *n.* A plant, *Papaver somniferum* native to Asia Minor, having grayish-green leaves and variously colored flowers; the dried juice of its unripe pods is the original source of opium.

opossum (ô-pôs-əm, pôs-əm) *n.* pl. **opossums** or **-sums**. [Port. *hutan*, opossum.] 1. A nocturnal, arboreal marsupial of the family Didelphidae, esp. *Didelphis marsupialis* of the Western Hemisphere. 2. A phalanger.

opponent (ô-pô-nənt) *n.* [Lat. *opponens*, *opponent*, one that opposes.] One that opposes another or others in a battle, contest, dispute, or debate. —*adj.* 1. Acting against an antagonist or an opposing force <opponent armies>. 2. Located in front.

opponent *n.* * *syns*: OPPONENT, ADVERSARY, ANTAGONIST, OPPOSER, OPPOSITION *n.* core meaning: one that opposes another in a battle, contest, controversy, or debate <had many opponents after the speech>.

opportune (ôp'ô-tūn, -tyōn) *adj.* [ME < OFr. *opportune* < Lat. *opportunus* : ob, to + *portus*, harbor.] 1. Favorable to or suited for a particular purpose <found an opportune moment to discuss my problem>. 2. Occurring at a fitting or advantageous time <an opportune encounter>. —**opportune** *adv.* —**opportune** *n.*

opportunism (ôp'ô-tū-niz-m, -tyōn-) *n.* One who takes advantage of conditions or circumstances for self-serving purposes, usu. without concern for principles or consequences. —**opportunistic** *adj.*

opportunistic (ôp'ô-tū-niz-tik, -tyōn-) *n.* pl. -tics. [ME *opportunitate* < OFr. < Lat. *opportunitas* < *opportunus*, opportune.] 1. Favorable or promising combination of circumstances. 2. A chance for advancement or improvement <a job opportunity>.

* *syns*: OPPORTUNITY, BREAK, CHANCE, OCCASION, OPENING. SHOT *n.* core meaning: a favorable time or circumstance <got an opportunity to buy stock>.

opposable (ô-pô-zə-bəl) *adj.* 1. Capable of being opposed. 2. Capable of being placed opposite or in opposition to something <an opposable thumb>. —**opposability** *n.*

oppose (ô-pôz) *v.* **-posed, -posing, -poses**. [Fr. *opposer* < OFr. < Lat. *opponere* : ob, against + *ponere*, to put.] —*vt.* 1. To be in conflict or contention with <oppose the invading army>. 2. To be in disagreement with or resistant to <oppose all radical changes>. 3. To place in opposition or be in opposition to.

ā pat ā pay ārcare ā father ē pet ē be hw which i tle i r pier ô pot ô toe ô paw, for oi noise: ô trol